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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/333,443 06/14/99 SCHUMACHER E 97-20A

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IM22/0223

EXAMINER

PRATT, H

ART UNIT

PAPER NUMBER

1761

DATE MAILED:

02/23/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/333,448

Applicant(s)

Schumacher

Examiner

Pratt, H.

Group Art Unit

1761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 8-12 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title should contain a reference to the method.

It is noted in the specification that the term "chitonase" is used. When a technical term has the ending 'ase", this usually means that the material is an enzyme. The term chitonase if incorrect should be changed to "chitosan". some instances of "chitonase" are found on page 3, line 6, and on page 4, 2nd paragraph.

Claim Rejections - 35 U.S.C. § 112

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 6, 9, 10, 11, 12 are indefinite in the use of the term "chitonase" which is an enzyme, which should probably be "chitosan", a polysaccharide.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. in view of Furda and Hennen.

Dunn et al. disclose a composition containing microcrystalline chitin which can be added to peanut butter. The reference states that the chitin should be used with an emulsifier in emulsion- type foods like mayonnaise (abstract and col. 6, lines 30-39). Claim 8 differs from the reference in the use of the term "chitonase", and in the use of fatty acids in the composition. The term "chitonase" has been discussed in the 112 rejection. Furda disclose that it is known to make a binder which binds oil by combining chitosan and fatty acid complexes (abstract and col. 3, lines 56-70, col. 4, lines 1-48). Also, Hennen discloses that it is known that chitosan stabilizes fats in food preparation., and binds free fatty acids (page 14, table 5, and page 6). Therefore, it would have been obvious to use the complex of Furda and Hennen in the composition of Dunn et al. for its known function of acting as an oil binder.

The particular amounts of ingredients are seen as within the skill of the ordinary worker to optimize. Therefore, it would have been obvious to use known ingredients in various amounts.

Claims 10-12 are considered to be a product by process claims. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the

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product-by-process claims. See Ex parte Jungfer 18 USPQ 2D 1796. It would have been obvious to make a composition as shown above.

Allowable Subject Matter

3. Claims 1-9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Pratt whose telephone number is (703) 308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Lacey, can be reached on (703) 308-3535. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3602 (unofficial faxes), **after final faxes 703 305 3599, and other official faxes 703 305 7718.**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HELEN PRATT

PRIMARY EXAMINER

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